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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,971	03/24/2005	Kazuhito Kawakami	62527 (49227)	3609
21874	7590	01/23/2006	EXAMINER	
EDWARDS & ANGELL, LLP			BOYKIN, TERRESSA M	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	

1711

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/517,971	<b>Applicant(s)</b> KAWAKAMI ET AL.	
	<b>Examiner</b> Terressa M. Boykin	<b>Art Unit</b> 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11-8-05.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,12 and 14 is/are rejected.
- 7) ☒ Claim(s) 3,9-11 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**Priority**

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 2, 4, 5, 6, 7, 8, 12, 14 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 5679451 cols. 1-7.**

The reference **USP 5679451** methods for preparing the *aggregated particle of the pigment, any of the following methods can be used*, from which at least one method may be selected as occasion calls.

(1) a method in which an electrolyte such as an anion, a cation or a salt is added to an aqueous *dispersion* containing the *pigment*, in an amount that may cause no thixotropy;

(2) a method in which the *pigment* is undergone self-agglomeration to produce secondary or tertiary, large xerogels, followed by wet-process or dry-process pulverization and further optionally classification;

(3) a method in which a shear force is applied to an aqueous dispersion containing the

*pigment, to effect agglomeration;*

(4) a method in which an aqueous *dispersion* containing the *pigment* is once dried to form xerogels having bonds between primary particles;

(5) a method in which a dispersant such as an acid is added to hydrogels of the *pigment*, followed by *dispersion* until the *pigment* comes to have a given *particle* diameter;

(6) a method in which an organic substance or the like is added to the *pigment*, and the mixture obtained is granulated by graft polymerization or the like;

(7) a method in which urea-formalin resin or the like is added to a *dispersion of the pigment* to effect agglomeration; and

(8) a method in which the pH of an aqueous dispersion containing the pigment is increased or decreased.

To the dispersion containing the pigment and the binder, it is possible to optionally add a dispersant, a *thickening agent*, a pH adjuster, a lubricant, a fluidity modifying agent, a surface active agent, a defoaming agent, a water-resisting agent, a foam controlling agent, a release agent, a foaming agent, a penetrating agent, a coloring dye, a fluorescent brightener, an ultraviolet absorbent, an antioxidant, an antiseptic agent and an antifungal agent.

The reference clearly recognizes that the shear stress may preferably be controlled to range from 0.1 to 100.0 N/m.<sup>2</sup>, which is variable depending on the viscosity, quantity or volume of the dispersion.

Claims 15 -18 of the reference disclose 15. that the recording medium has a the

weight ratio of the *pigment* to the binder is in a range of from 1:1 to 30:1 wherein the binder is a water-soluble polymeric substance wherein the binder is a material selected from the group consisting of polyvinyl alcohol, cation-modified polyvinyl alcohol, anion-modified polyvinyl alcohol, silanol-modified polyvinyl alcohol, starch, gelatin, casein, carboxyethyl cellulose, hydroxyethyl cellulose, hydroxypropyl cellulose, SBR, NBR, methyl methacrylate butadiene copolymer, ethylene vinyl acetate copolymer, polyvinyl pyrrolidone, maleic anhydride and acrylic ester copolymer.

With regard to applicants claim 14, it is apparent from the reference that that the pigment particles may be used as additives for paints, coating materials, powder coatings etc.

### **Objected Claims**

Claims 9, 10, 11, 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims

### **Correspondence**

Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is ( 571-272-1700).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tmb

  
**Examiner Terressa Boykin**  
**Primary Examiner**  
**Art Unit 1711**